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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/501,559	02/09/2000	Manjit S. Chowdhary	ECO530/4-2	4061

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EXAMINER

TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 12/06/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

501559

Applicant(s)

CHOWDHARY ET AL

Examiner

P. TUCKER

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 9/21/01
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1 - 40 is/are pending in the application.
- Of the above claim(s) 12 - 26, 33 and 40 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1 - 11, 27 - 32, 34 - 39 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

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DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of I in Paper No. 5 is acknowledged. The traversal is on the ground(s) that claims 33 and 40 should be allocated to invention I. This is not found persuasive because claims 33 and 40 suffer from lacking clarity under 35 USC 112. These claims fail to further limit the method of the parent claims, and claim the finished powder in various compositions. The scope of these claims are not clear if they are drawn to compositions or methods. If for instance claim 33 is taken as a method claim, the powder would be an agent in for example a drilling fluid, thus it would be impossible for step d) of parent claim 27 to happen, since the drying of the drilling fluid could not take place, and still constitute a drilling fluid. A proper method claim would state that the powder is further used to prepare the fluid, or include a further step of such preparation. Similar holds true for claim 40. The claims were thus treated as product and not method claims, since they were improper method claims drawn to products formed from the intermediate powder that was formed. Applicant may place the claims in proper method form, but such would still be subject to further restriction. It is also notoriously well known in the art of oil field chemistry of using pad fluids which comprise guar, prior to using fracturing fluids which contain guar and proppant, along with significant other uses for guar. The examiner is not required to produce an affidavit for that which is well known in the art.

The requirement is still deemed proper and is therefore made FINAL.

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Claim Objections

2. Claim 2 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Guar is a polygalactomannan, thus claim 2 fails to further limit claim 1..

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "is screened in said screening step" has no antecedent basis in claim 11 or parent claim 2.

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Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-11, 27-32 and 34-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rutenberg et al. (4269975).


Rutenberg teaches a method of preparing a ground guar which is made from hydrated guar splits (see abstract). Rutenberg teaches that extruding the guar, prior to grinding results in a gum which produces increased viscosity products (see Example II). Rutenberg also teaches that flaking of the guar prior to grinding, results in a product with higher viscosity than nonflaked guar (column 7, lines 4-20). Rutenberg differs from the present invention in that the use of both flaking and extruding, in the preparation of the ground guar is not disclosed. It would however be obvious to one of ordinary skill in the art to utilize both extruding and flaking of the guar, in the process of making ground guar, given the teaching of Rutenberg that extruding and flaking produce superior ground guar from guar splits, than guar not subject to extruding or flaking. Rutenberg also differs in not specifying an extruding barrel of 2 - 8 inches, or the use of chemically or genetically modified guar. The utility of barrels of differing size, in order to optimize the processing of the guar would be an obvious variation to one of ordinary skill in the

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art (In re Rose 105 USPQ 237). The utility of chemically or genetically modified guar as an alternative to guar in the industrial uses disclosed by Rutenberg at column 1, lines 8-12 are well known, and would be obvious to one of ordinary skill in the art.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tucker whose telephone number is (703) 308-0529. The examiner's normal working hours are 7:30am-4:00pm, Monday-Friday. If necessary SPE Robert Dawson may be contacted at 703-308-2340. For inquiries of a general nature call the receptionist at 703-308-0651. The group FAX no. is 703-872-9310. The **after final** fax no. is 703-872-9311.

PCT-2348
December 3, 2001


PHILIP C. TUCKER
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